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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ANTON et al.

Application No.

Art Unit: 1772

Filed: June 19, 2001

Examiner: P. Nordmeyer

For: MICROPOROUS HEAT INSULATION BODY

RESPONSE

#14

Mail Stop Patent AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The instant paper is submitted in reply to the final Office Action mailed December 12, 2002, following the Notice of Appeal filed June 2, 2003.

In accordance with the final Office Action, claims 1-4 stand provisionally rejected for obviousness-type double patenting based on claims 1-7 of co-pending application no. 09/857,182. Applicants maintain that the rejection is not ripe for reply, as explained in the remarks to their amendment filed October 15, 2002 ("the previously filed amendment"), at page 7. Accordingly, when the rejection is no longer provisional, applicants will address the rejection.

Claims 5 and 6 remain rejected under 35 USC 103(a) based on the combined teachings of Kratel and Takahashi, and claims 7-9 remain rejected under 35 USC 103(a) based on the combined teachings of Kratel, Takahashi and Sklarski. Reconsideration is requested.

First of all, applicants incorporate herein by reference the remarks addressing these rejections as set forth in the previously filed amendment, pages 2-6.

Secondly, applicants submit herewith the Rule 132 declaration of co-inventor Octavian Anton ("the Rule 132 declaration"). The Rule 132 declaration provides, *inter alia*, details of the tests performed and results obtained as summarized in the Experimental report filed as an attachment to the previously filed amendment. The Rule 132 declaration provides comparative test results, which demonstrate that the presently claimed product "manufactured by dry-compressing" (using pyrogenic silica as the "finely divided metal oxide") is patentably distinct from the prior art product manufactured by *wet-processing* relied on to reject the claims.

According to the statement of rejection, lack of patentability is based on the theory *inherency*; that is, the statement of rejection alleges that the prior art relied on to reject the claims *inherently* discloses the presently claimed product, based on alleged similarities between the process used to make the prior art product, on the one hand, and the process used to make the presently claimed product, on the other. However, as demonstrated in the Rule 132 declaration, the prior art product is not, in fact, the presently claimed product.

The Rule 132 Declaration shows that the wet-processing-produced, prior art products cracked, whereas the product according to the presently claimed invention, prepared using dry-processing as opposed to the wet-processing used to prepare the prior art products, did not crack. In view of the showing, the rejections are in order for withdrawal. Therefore, withdrawal of the rejections under section 103(a) is in order.

In submitting the Rule 132 declaration, applicants do not acknowledge that a *prima facie* case of obviousness under section 103(a) has been established with respect to each of the rejections under

section 103(a). On the contrary, as indicated above, applicants maintain their traversal of the rejections as set forth in the previously filed amendment. In addition, applicants submit that the rejections cannot be maintained because they fail to apply the correct standard for determining obviousness under section 103(a).

According to the statement of rejection, (final Office Action, page 3):

In this case, the limitation of dry compressing is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. [*Citations omitted.*]

The aforesaid quoted text does not correctly reflect the rule of law with respect to process limitations recited in a product-by-process claim.

All claim limitations must be considered in a determination of obviousness under section 103(a). *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970). Moreover, "it is error to ignore specific limitations distinguishing over the reference [cited]." *Ex parte Murphy*, 217 USPQ 479, 481 (POBD.APP.1982). When the PTO relies on a theory of inherency to reject the claims, the allegedly inherent feature must be an *inevitable* result of the express teachings of the reference. *In re Newell*, 13 USPQ2d 1248 (Fed. Cir. 1989). *In re Spoorman*, 150 USPQ449 (CCPA 1966).

In relying on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.

*Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPA & I 1990) (*emphasis in original*). Before "the burden shifts" the examiner has "the initial burden of establishing a prima facie basis for the alleged inherency." *Levy*, 17 USPQ2d @1463-64.

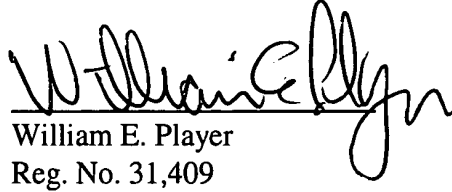
In the present case, the statement of rejection has failed to provide any evidence or scientific evidence, whatsoever, to support the allegation that *wet-processing* in accordance with the prior art is essentially identical to "dry-processing" in accordance with the present claims. Since it has not been shown that both reactants and reaction conditions of wet-processing, as disclosed in the prior art, are essentially identical to "dry-processing," as presently claimed, the PTO has failed to establish the prima facie case necessary to shift the burden to applicants to provide rebuttal evidence. *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990). It is "incongruous" to find "different processes each inherently produce identical products." *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Unpatentability of an invention "set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result in the practice of processes disclosed in references." 220 USPQ at 314.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By

  
William E. Player  
Reg. No. 31,409

400 Seventh Street, N.W.  
The Jenifer Building  
Washington, D.C. 20004  
Tel. (202) 638-6666  
Fax (202) 393-5350  
Date: August 4, 2003  
WEP/bap